

Response to Office Action
SN 10/697,404
Customer No. 33354

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REMARKS

I. Claim Status

Claims 1-25 are pending in the application. Claims 22-25 are cancelled herein.

Applicants thank the Examiner for allowing claims 20 and 21 as written.

II. Claim Rejection Under 35 USC §102(b)

A. Farey Does Not Anticipate Claims 1, 4-6, and 8-11

The Examiner has rejected claims 1, 4-6, and 8-11 as being anticipated by U.S. Pat No. 4,366,964 issued to Farey. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051 at 1053 (Fed. Cir. 1987). To anticipate, all limitations of the claim must be found in the reference or be "fully met" by it. *Lalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983).

1. Farey Does Not Disclose an Insert

Applicants' independent claim 1 requires an insert fit between the pushrim and the wheel. Farey does not disclose, either expressly or inherently, an insert between the pushrim and wheel. Instead, Farey discloses that the surface between the pushrim and the wheel is a "unitary construction wherein the hand rim and wheel are portions of a single integrally formed metal member..." Farey at column 5, lines 53-55 and Fig. 3. Thus, because the hand rim and pushrim are integral with each other, the connecting portion between them is not an insert.

Because Farey does not disclose each and every limitation as set forth in the claims, Farey does not anticipate Applicants' claimed invention and Applicants respectfully request that this rejection be withdrawn.

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2. Farey Does Not Disclose a Compressible Insert

Applicants' independent claim 1 requires that the insert be compressibly fit between the pushrim and the wheel. Farey does not disclose, either expressly or inherently, that the surface between the pushrim and wheel be compressible. Instead, Farey discloses that the surface between the pushrim is a web portion 67 and that the web portion 67 serves to "space the hand rim and the wheel rim apart, tak[ing] the place of the standoff mountings described above." Farey at column 5, lines 57-59 and Fig. 3. Farey discloses that the standoffs are tubes of metal that are used to space the hand rim from the wheel rim. Farey at column 4, lines 33-35. As explained in Farey at column 5, lines 22-27, the standoff enables the user to wrap his thumb downwardly over the top of the hand rim. If the standoff and web-portion were compressible, the user's thumb could be pinched between the hand rim and wheel during use. Obviously that is not intended or inherently disclosed by Farey. Thus, because the hand rim and wheel rim in Farey are separated by a standoff or surface that expressly and inherently separates the hand rim from wheel rim, the standoff or surface is not compressible.

Because Farey does not disclose each and every limitation as set forth in the claims, Farey does not anticipate Applicants' claimed invention and Applicants respectfully request that the rejection be withdrawn.

3. Dependent Claims 4-6 and 8-11 are Not Anticipated

Claims 4-6 and 8-11 are dependent on claim 1 and therefore incorporate an insert that is compressibly fit. As explained above, because Farey does not disclose an insert or that the insert is compressible, Farey does not disclose every limitation in these claims. Therefore, Farey does not anticipate claims 4-6 and 8-11 and Applicants respectfully request that the rejection be withdrawn.

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B. Farey Does Not Anticipate Claims 13, 15-16 and 18-19

The Examiner has rejected claims 13, 15-16 and 18-19 as being anticipated. Farey. Again, to anticipate, all limitations of the claim must be found in the reference or be "fully met" by it. *Lalman*.

1. Farey Does Not Disclose an Insert

Applicants' independent claim 13 requires an insert fit between the pushrim and the wheel. Farey does not disclose, either expressly or inherently, an insert between the pushrim and wheel. Instead, Farey discloses that the surface between the pushrim and the wheel is of unitary construction. Farey at column 5, lines 53-55 and Fig. 3. Thus, because the hand rim and pushrim are integral, the connecting portion is not an insert.

Because Farey does not disclose each and every limitation as set forth in the claims, Farey does not anticipate Applicants' claimed invention and Applicants respectfully request that this rejection be withdrawn.

2. Dependent Claims 15-16 and 18-19 are Not Anticipated

Claims 15-16 and 18-19 are dependent on claim 13 and therefore incorporate an insert. Because Farey does not disclose each and every limitation as set forth in the claim 13 as explained above, Farey does not anticipate 15-16 and 18-19 and Applicants respectfully request that the rejection be withdrawn.

III. Claim Rejection Under 35 USC §103

A. Desouza Not Analogous

The Examiner has rejected claims 7 and 17 as being obvious in light of Farey in view of U.S. Pat No. 5,938,184 issued to Desouza. In order to determine whether an invention is obvious in light of prior art, the Patent Office should make several basic factual inquiries, including the scope and content of the prior art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The scope of the

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prior art should include only analogous prior art. MPEP §2141.01(a). In general, in order for a reference to be considered analogous prior art, the reference must either be in the field of applicant's endeavor or, if not, be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992) (holding that fasteners for garments are not analogous art for an obviousness rejection of fasteners for a hose clamp); see also *In re Clay*, 966 F. 2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). Moreover, it is also necessary that a person of ordinary skill, seeking to solve a particular problem, would reasonably be expected or motivated to look to the allegedly analogous technology. *In re Oeticker*, 24 USPQ2d at 1446.

Applicants' field of endeavor is wheelchairs. The stated objectives of their work are concerned with solving problems of the comfort and efficiency of wheelchair pushrims. See Applicants' specification page 3, second full paragraph. Desouza is concerned with solving problems of how to more easily fabricate fence posts. See Desouza Column 2, lines 32-33. Thus, Desouza is not in Applicants' field nor reasonably pertinent to the particular problem with which the inventors were concerned, and a person skilled in the art of wheelchairs would not reasonably be expected or motivated to consider fence post fabrication in solving the problems at issue, namely hand rim comfort and efficiency.

Consequently, Desouza cannot be considered analogous art and, accordingly, there is no motivation to combine Desouza and Farey. Therefore, no *prima facie* case of obviousness has been established. Applicants respectfully request that this rejection be withdrawn.

B. Farey Does Not Teach or Suggest a Claimed Element

The Examiner has asserted that Farey teaches all of the claimed elements of Applicants' invention, except for a rib to improve structural strength. A claim is *prima facie* obvious only if the prior art reference teaches or suggests all of the

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claim limitations. MPEP §2143. Assuming *arguendo* that Desouza is analogous art, the cited references fail to teach an element of Applicants' claimed invention.

1. Claim 7 Not Obvious because Compressible Insert Not Taught by Cited References

As to claim 7, Applicants' claimed invention requires an insert that is compressibly fit. However, neither Farey nor Desouza teach or suggest an insert or a compressible insert. The arguments of Section III.A. (1) and (2) are incorporated herein. The cited references fail to teach or suggest all of the claim limitations and a *prima facie* case of obviousness has not been made. Therefore, Applicants respectfully request that this rejection be withdrawn.

2. Claim 17 Not Obvious because Insert Not Taught by Cited References

As to claim 17, Applicants' claimed invention requires an insert. However, neither Farey nor Desouza teach or suggest an insert. The arguments of Section III.A. (1) are incorporated herein. Therefore, the cited references fail to teach or suggest all of the claim limitations and a *prima facie* case of obviousness has not been made. Therefore, Applicants respectfully request that this rejection be withdrawn.

IV. Conclusion

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance. Applicants respectfully


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request that the Examiner allow the application to proceed to issuance.

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Dated

Respectfully submitted,


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